

Remarks

I. Status of the Application and Claims

As originally filed, the present application had a total of 22 claims. In a Preliminary Amendment, Applicants cancelled claims 1, 2, 6-13, 15, 17 and 19, and added new claims 23-28. Claims 20-22 and 25-28 were withdrawn as the result of a restriction requirement. All of the remaining claims have been canceled herein. Thus, the claims now pending are 29-35.

II. The Amendments

In accordance with the request of the Examiner appearing on page 5 of the Office Action, Applicants have canceled all pending claims and have presented a clean copy as new claims 29-35. These have been rearranged so that original claims 23 and 24 are now claims 29 and 30. Original claims 3-5 are now 31-33. Original claim 14 has become claim 34; original claim 16 was not replaced; and original claim 18 has become new claim 35.

The changes that have been made to the claims are as follows:

- 1) The term "prodrug" was deleted from claim 32 and 34;
- 2) The variables set forth for R^2 were amended in paragraphs iii and iv to clarify what is being modified by the options presented;
- 3) The definition of Y was read from claim 29 into claim 31;
- 4) A proviso was added to claim 23 (now claim 29) to expressly exclude a prior art compound identified by the Examiner.

None of the changes made add new matter to the application, and their entry is therefore respectfully requested.

III. Claim Objections

On page 3 of the Office Action, the Examiner objects to claims 3, 5 and 14 alleging that they are multiply dependent claims that refer back to a multiply dependent base claim. Applicants believe that this problem no longer exists for any of the claims now pending. It therefore appears that the Examiner's rejection has been overcome.

The Rejections

I. Rejection of claims Under 35 U.S.C. § 112, Second Paragraph

On pages 3 and 4 of the Office Action, the Examiner rejects claims 23 and 24 under 35 U.S.C. § 112, second paragraph. It is alleged that claim 23 is indefinite because it includes the term “prodrug.” Since Applicants have eliminated this term from the amended claims submitted herein, it is respectfully submitted that the Examiner’s rejection has been overcome.

It is also alleged that claims 23 and 24 are unclear with respect to the options available for R². In response, Applicants have amended the claims to better specify the compounds modified by various options, especially with respect to “q.”

Applicants believe that these Amendments are sufficient to overcome the Examiner’s rejection, and that the claims now fully comply with 35 U.S.C. § 112, second paragraph.

II. Rejection of Claims Under 35 U.S.C. § 102

On pages 4 and 5 of the Office Action, the Examiner rejects claims 4, 23 and 24 based upon the allegation that they are anticipated by a compound disclosed in an abstract by Engel *et al.* (CAPLUS abstract DE 19544687). The compound was designated as 191868-11-8 and allegedly falls within the scope of Applicants’ genus claims, *i.e.*, claims 23 and 24, when R¹=R²=R³=R⁴=R⁵=H, and n=m=1.

In response, Applicants have introduced a proviso into claim 29 (corresponding to cancelled claim 23) which requires that whenever R¹, R², R³, R⁴ and R⁵ are all hydrogen, then m + n must be greater than or equal to 4. By extension, the proviso applies to all claims that are dependent upon 29. The closest compound that could be constructed from the claims now differs from the compound disclosed by Engel by two methylene groups. Therefore Engel is no longer anticipatory.

Unlike claims 23 and 24 (now 29 and 30) claim 4 was not amended. After having reviewed this claim, Applicants could find no compound corresponding to the compound disclosed by Engel. It is respectfully requested that the Examiner reconsider the rejection of

this claim. If he would then still like to maintain the rejection, Applicants respectfully request that he specifically point out the particular compound in the claim 32 (formerly claim 4) that corresponds to the one disclosed by Engel.

Conclusion

In light of the amendments and discussion above, Applicants submit that all of the Examiner's rejections have been overcome. It is therefore respectfully requested that these rejections be withdrawn and that the claims presently pending in the application be allowed.

If, in the opinion of the Examiner, a phone call may help to expedite the prosecution of this application, the Examiner is invited to call Applicant's undersigned attorney at (703) 905-2173.

Respectfully submitted,

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